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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/056,096 | 01/24/2002 | Kevin R. Boyle | GB 010021 | 9447 |

24737 7590 09/09/2004

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

PAN, YUWEN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2682

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DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|-------------------------------|------------------------------|--|
| <p align="center">Office Action Summary</p> | Application No. 10/056,096 | Applicant(s) BOYLE ET AL. | |
| | Examiner Yuwen Pan | Art Unit 2682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2,4</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of copending Application No. 09/912470. Although the conflicting claims are not identical, they are not patentably distinct from each other because the referenced copending application and the instant application are claiming common subject matter, as follows: a wireless terminal comprising a ground conductor and a transceiver coupled to an antenna feed, wherein the antenna feed is coupled directly to the ground conductor via a capacitor formed by a conducting plate and a portion of the ground conductor and a slot is provided in the ground conductor

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engblom et al (US006002367A) in view of Hall (U.S. Patent # 4,587,524).

Per claim 1, Engblom discloses a wireless terminal (column 1 and lines 47-50) comprising:

a ground conductor and a transceiver coupled to an antenna feed (see figure 1 and column 2 and lines 40-column 3 and line 4),

wherein the antenna feed is coupled directly to the ground conductor via a capacitor formed by a conducting plate and a portion of the ground conductor (see figure 10B and items 1 and 40) and

a slot is provided in the ground conductor (see figure 10B and item 5, column 2 and lines 52-53).

Engblom doesn't teach that said slot is partially located underneath the conducting plate.

Hall teaches that the conducting plate is big enough to cover part of the slot (see figure 3 and column 3 and lines 25-40).

It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teaching of Hall with Engblom's apparatus such that the impedance and cardioids radiation characteristics over a wide bandwidth is maintained (see Hall, column 2 and lines 37-45).

Per claim 2, Engblom further teaches that slot is parallel to the major axis of the terminal (see figure 1).

Per claim 3, Engblom further teaches that slot is folded (see figure 10B and item 5).

Per claim 4, Hall further teaches that a further slot, also partially located underneath the conducting plate, is provided in the ground conductor (see figure 3 and item 42).

Per claim 5, Engblom further teaches that the conducting plate is asymmetrical with respect to the major axis of the ground conductor (see figure 10B).

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engblom et al (US006002367A) and Hall (U.S. Patent # 4,587,524) as applied to claim 1 above, and further in view of Sanford et al (US006424300B1).

Per claim 6, combination of Engblom and Hall doesn't teach that the ground conductor is a handset case. Sanford teaches that the ground conductor is a handset case (see figure 4A, item 400). It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teaching of Sanford with the combination of Hall and Engblom such that it eliminate the need for an additional antenna component.

Per claim 7, Sanford further teaches that the ground conductor is a printed circuit board ground plane (see column 11 and lines 30-35).

Per claim 8, Sandford further teaches that a matching network is provided between the transceiver and the antenna feed (see column 11 and lines 15-25).


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuwen Pan whose telephone number is 703-305-7372. The examiner can normally be reached on 8-5 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Xuwen Fan
September 2, 2004


LEE NGUYEN
PRIMARY EXAMINER